

REMARKS

Applicant appreciates the time taken by the Examiner to review Applicant's present application. This application has been carefully reviewed in light of the Official Action mailed March 30, 2004. Applicant has amended Claims 1, 13 and 21, and added Claims 27-29. Applicant respectfully submits that no new matter has been added by the amendments. Therefore, Claims 1-29 remain pending in the application. Applicant respectfully requests reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 102

Claims 1, 2, 5, 6, 8-13, 15, 16, 21 and 23 stand rejected as anticipated by U.S. Patent No. 6,216,186 ("Mayhead"). Applicant respectfully traverses this rejection.

Claim 1, as amended, recites providing a primary electronic component having a first identifier stored therein, wherein the first identifier includes branding information, providing a secondary electronic component having a second identifier stored therein, wherein the second identifier includes branding information, coupling the secondary component to the primary component, comparing the first identifier to the second identifier, and operating the primary component and the secondary component based on the comparison of the first identifier and the second identifier. In some embodiments, these identifiers are brand identifiers corresponding with the manufacturer of the first and second components. The primary and secondary components may be operated based on the comparison of these brand identifiers. If the brand identifiers match, the primary and secondary components may be operated in conjunction with one another, if the first and second identifiers do not match the primary component may be operated without the secondary component. Additionally, however, the primary component may be operated in conjunction with the secondary component if the first and second identifiers do not match or the primary component may be operated without the secondary component if the first and second identifiers do match. Thus, the comparison of the first and second identifiers may not determine the functional compatibility of the primary and secondary component, rather this comparison may whether to allow interoperation of components based on branding of the primary and secondary components.

In contrast, Mayhead discloses a module utilizing requirement indicators defining features of a component required for a module to operate, capability indicators defining features provided by the module and ability indicators defining features of a component

acceptable to the module. (Col. 1, Lines 50-54) This module may be plugged into a system which provides its own capabilities and requirements. A comparison then takes place between the capabilities and requirements of the module and the system. If the logical comparison of requirements and capabilities is true then the system accepts the module as being compatible. If the logical comparison is false then the module is rejected. Indeed, feature types must precisely match for the products to be compatible. (Col. 7, Lines 54-56) Thus, the various identifiers in Mayhead are used solely to determine the compatibility of the module and the system, and the module is activated or deactivated based solely on this compatibility determination. (Col. 8, Lines 30-55).

Furthermore, nowhere in the portions cited by the Examiner does Mayhead disclose first and second identifiers, wherein the first and second identifiers include branding information. Mayhead only discloses requirement indicators defining features of a component required for the module to operate, capability indicators defining features provided by the module and ability indicators defining features of the component.

Consequently, as Mayhead does not disclose every limitation of Claim 1, and is only operable to determine compatibility between a module and component, Applicant respectfully requests the withdrawal of the rejection of Claim 1 and its dependent Claims 2, 5, 6 and 8-12. Additionally Applicant respectfully submits that the arguments regarding Claim 1 are equally applicable to independent Claims 13 and 21, and respectfully requests the withdrawal of the rejection of independent Claims 13 and 21 and their respective dependent Claims 15-16, 21 and 23.

Rejections under 35 U.S.C. § 103

Claims 3, 4, 14, 17, 18, 22, 25 and 26 stand rejected as obvious over U.S. Patent No. U.S. Patent No. 6,216,186 ("Mayhead") in view of U.S. Patent No. 6,661,236 ("Goers"). Applicant respectfully traverses this rejection.

In order to establish a prima facie case of obviousness, the Examiner must show: that the prior art references teach or suggest all of the claim limitations; that there is some suggestion or motivation in the references (or within the knowledge of one of ordinary skill in the art) to modify or combine the references; and that there is a reasonable expectation of success. M.P.E.P. 2142, 2143; *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). The Examiner must explain with reasonable specificity at least one rejection – otherwise, the Examiner has failed procedurally to establish a prima facie case of obviousness.

M.P.E.P. 2142; Ex parte Blanc, 13 U.S.P.Q.2d 1383 (Bd. Pat Application. & Inter. 1989). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper. Ex parte Skinner, 2 U.S.P.Q.2d 1788, 1790 (Bd. Pat. App. & Inter. 1986).

The Applicant respectfully points out that the Examiner has failed to establish a *prima facie* case of obviousness. More specifically, the Examiner has not shown that the references disclose every limitation of the claims, that there is any suggestion or motivation in the references to combine or modify them, or that the combination of the two would enjoy a reasonable expectation of success. Consequently, the rejection must fail.

Applicant respectfully submits that the above arguments presented with respect to independent Claims 1, 13 and 21 apply equally well to dependent Claims 3, 4, 14, 17, 18, 22, 25 and 26.

Additionally, Mayhead discloses a system operable for logically determining compatibility between modules and the system. These apparatuses may be used to establish compatibility between hardware or software modules components. A software module could be for integration with other software modules or with hardware. In the case of a hardware module, the hardware module must be electrically and logically connected to the system before the logical evaluation of the capabilities, features and compatibility of the module and system can take place. This entails connection of the module to a single bus on which the processor and memory reside. In the case of a software module, the capabilities and features of the module may be provided via disk, tape or any other carrier medium. Evaluation of the compatibility of a software module may be accomplished without connection of the software module to a bus. If the hardware or software module is not compatible with the system, the module is logically isolated from the system.

Goers discloses a system which establishes the connection between a base unit and a pluggable electrical unit initially only partially, and only to the read-only memory, after switching on the power supply to the pluggable electrical unit. This initial connection is established on a first bus which connects the read-only memory of the pluggable electrical unit to the testing logic of the base unit. If the base unit and the pluggable electrical component are not compatible the pluggable electrical unit is electrically isolated from the base unit. However, if the base unit and the pluggable electrical are compatible, they are fully coupled using a second bus.

The Examiner states it would have been obvious to apply the second interconnect of Goer to Mayhead's system to take advantage of the I2C protocol. Applicant respectfully disagrees. Mayhead logically evaluates the compatibility of both hardware and software module with a system, in the case of a software module, the software module may only be logically connected to the system, and in the case where the software module is incompatible with the system, the software module is logically isolated. Similarly, an incompatible hardware module is logically isolated from the system. In contrast, Goer electrically isolates incompatible modules from the base unit. To apply the second bus of Goer to connect the modules of Mayhead to the system would render the system of Mayhead inoperable for testing software modules and for logically isolating incompatible modules. As applying the second bus of Goer to the system of Mayhead would render Mayhead inoperable for its intended purpose, the combination of the two would not enjoy a reasonable expectation of success and consequently would not have been obvious to one of ordinary skill in the art at the time the invention was made. Accordingly, withdrawal of the rejection of Claims is respectfully requested.

Claims 7, 19, 20 and 24 stand rejected as obvious over U.S. Patent No. U.S. Patent No. 6,216,186 ("Mayhead") in view of U.S. Patent No. 6,661,236 ("Nolan"). Applicant submits that the above arguments with respect to Claims 1, 13 and 21 apply equally well to the rejection of Claims 7, 19, 20 and 24 and accordingly requests the withdrawal of the rejection of these claims as well.

CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for allowance. Other than as explicitly set forth above, this reply does not include an acquiescence to statements, assertions, assumptions, conclusions, or any combination thereof in the Office Action. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests full allowance of Claims 1-29. The Examiner is invited to telephone the undersigned at the number listed below for prompt action in the event any issues remain.

The Director of the U.S. Patent and Trademark Office is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 50-0456 of Gray Cary Ware & Freidenrich, LLP.

Respectfully submitted,

**Gray Cary Ware & Freidenrich LLP**  
Attorneys for Applicant

Ari G. Akmal  
Reg. No. 51,388

Date: June 24, 2004

1221 South MoPac Expressway, Suite 400  
Austin, TX 78746-6875  
Tel. (512) 457-7216  
Fax. (512) 457-7001